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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,231	04/22/2005	Naresh Kumar	4137-44	7197
23117 7590 05/19/2009 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER				
GUDIBANDE, SATYANARAYAN R				
ART UNIT		PAPER NUMBER		
1654				
MAIL DATE		DELIVERY MODE		
05/19/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/525,231

**Applicant(s)**

KUMAR, NARESH

**Examiner**SATYANARAYANA R.  
GUDIBANDE**Art Unit**

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 February 2009.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 142, 144-146, 148, 158, 236-249 is/are pending in the application.  
4a) Of the above claim(s) 237-239 and 241-243 is/are withdrawn from consideration.  
5) ☒ Claim(s) 148, 158 and 244-249 is/are allowed.  
6) ☒ Claim(s) 142, 144-146, 236 and 240 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Applicant's amendment to claims 142 and 158 in the response filed on 2/9/09 has been acknowledged.

Applicant's election with traverse of group II invention and election of the following compound,



as the species in the reply filed on 8/24/07 is acknowledged. The traversal arguments were answered in the office action dated 10/17/07.

A search for the elected species indicated that it is free of prior art. The species recited in claims 148 and 249 have also been found to be free of art.

### *Allowable Subject Matter*

Claims 148, 158 and 244-249 are allowable over prior art.

Applicant's remarks and amendment to claims in the response filed on 10/7/08 has been acknowledged.

Claims 142, 144-146, 148, 158, 236-249 are pending.

Claims 1-141, 143, 147, 149-157, 159-235 have been canceled.

Claims 237-239 and 241-243 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 8/24/07.

Claims 142, 144-146, 148, 158, 236, 240 and 244-249 are examined on the merit.

Any objections and/or rejections made in the last office action dated 11/7/08 and not specifically discussed in its original or modified form here are considered withdrawn.

***New grounds of rejections***

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

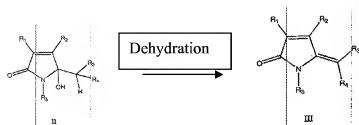
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

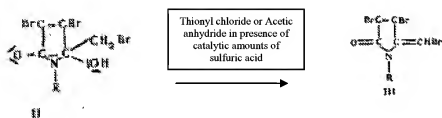
1. Claims 142, 144-146, 236 and 240 are rejected under 35 U.S.C. 102(b) as being anticipated by Kalnina, 1972, Latvijas PSR Zinatnu Akademijas Vestis, Kimijas Serija, 1, 110-113 (translated copy of the article is enclosed).

In the instant invention, applicant's claim a method of preparing a compound of formula III according to the reaction scheme shown below:

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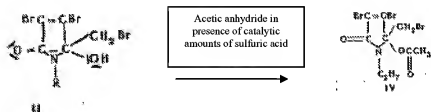


Kalnina discloses the reaction following schemes:



where R = -CH<sub>3</sub>

and



where R = -C<sub>3</sub>H<sub>7</sub> (the above reaction scheme is derived from the information on pages 3-5 of the translated document). The disappearance of the hydroxyl absorption band at 3250-3350 cm<sup>-1</sup> and appearance of the absorption band for the C=C at 1564 cm<sup>-1</sup> indicates the formation of the dehydrated products III and IV. This reads on the instant method and the instant compounds II and III. Compounds III and IV of Kalnina also discloses compounds that are brominated at positions that corresponds R<sub>1</sub>, R<sub>2</sub>, R<sub>3</sub> of the instant compounds II and III. Hence reads on the instant claims 142, 146, 236, and 240. The dehydration procedure used by Kalnina reads on the

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instant claim 142 and 144. The use of acetic anhydride and sulfuric acid in the reaction scheme reads on the instant claim 145.

2. Claims 146 is rejected under 35 U.S.C. 102(b) as being anticipated by Roedig, 1960, Justus Liebigs Annalen Der Chemie, 636, 1-18 (copy of the translation enclosed).

In the instant invention, applicant's claim a compound of formula III as shown below:



Roedig discloses a compound of the formula XXIII (on page 16 of the translation):



that reads on the instant compound III wherein  $R_1-R_4 = \text{Cl}$  and  $R_5 = \text{H}$ . This meets the limitation of instant claim 146.

**Art of Record:** The following are the other references that are relevant to the instant claimed invention. Copies of the same have been enclosed for applicant's benefit.

3. Clark, 1999, Tetrahedron Letters, 40, 8619-8623. The compound **6a** (on page 8621) anticipates the compound III of instant invention.

4. Augustine, 1979, Journal Fur Praktische Chemie, 321, 797-803 (copy of the translation enclosed). The compound 2 disclosed on page 2 (translation) and compound 10-14 on page 3 (translation) reads on the compound III of instant invention.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

This application contains claims 237-239 and 241-243 drawn to an invention nonelected with traverse in the reply filed on 10/17/07. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satyanarayana R. Gudibande whose telephone number is 571-272-8146. The examiner can normally be reached on M-F 8-4.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Satyanarayana R Gudibande/  
Examiner, Art Unit 1654

/Andrew D Kosar/  
Primary Examiner, Art Unit 1654